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09/241,188

02/01/1999

MICHAEL BLANDINA

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8363

7590

12/28/2005

BRETT CARLSON INTELLECTUAL PROPERTY  
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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/241,188

### Applicant(s)

BLANDINA ET AL.

### Examiner

James H. Zurita

### Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Prosecution History***

The following is provided to clarify the record.

On 1 February 1999, applicant filed the instant application. Applicant claims priority to application 09/105406, filed 26 June 1998, now abandoned. Related application PCT/US99/12118 is a continuation of application 09/105406.

On 28 September 2001, the Examiner rejected claims 1-9 as anticipated by Schein (US 6,226,623).

On 2 January 2002, applicant cancelled claims 1-19 and added claims 20-35.

On 7 March 2002, the Examiner issued a final rejection of claims 20-35 as anticipated by Schein, above.

On 7 May 2002, applicant filed an after-final amendment.

On 30 May 2002, the Examiner reopened prosecution and rejected claims 20-35 as unpatentable over Schein, above, in view of Owens (US 6,047,267).

On 30 August 2002, applicant amended claims 20, 28-29 and cancelled claim 24.

In a 19 November 2002 final-rejection, the Examiner rejected claims 20-23 and 25-35 as unpatentable over Schein and Owens, above.

On 4 April 2003, applicant filed an after-final amendment and requested reconsideration. Applicant amended claims 20, 28 and 29.

On 18 April 2003, the Examiner issued an advisory action.

On 28 April 2003, applicant filed a notice of appeal.

On 28 May 2003, applicant filed a first Request for Continued Examination.

On 13 August 2003, the Examiner entered the amendment of 4 April 2003 and rejected claims 20-23 and 25-35 as unpatentable over Schein in view of Owens, above.

On 13 November 2003, applicant filed a response. On 15 December 2003, Applicant faxed a Substitute Response.

On 19 April 2004, the Examiner issued a final rejection of claims 20-23, 25-27 and 29-35 as unpatentable over Schein and Owens, above.

On 21 June 2004, applicant filed an after final amendment.

On 23 July 2004, the Examiner issued an advisory action.

On 19 August 2004, applicant filed a second Request for Continued Examination.

On 22 September 2004, the Examiner rejected claims 20, 21, 29-35 as unpatentable over Schein and Owens, above.

On 27 December 2004, applicant cancelled claims 20, 21 and 29-35 and added claims 36-43. Claims 36-43 remained.

On 6 April 2005, the Examiner issued a final rejection of claims 36-43 as unpatentable over Schein and Owens, above.

On 7 October 2005, applicant filed a third Request for Continued Examination. Applicant amended claim 36 and added claims 44-48.

The present Office Action is in response to the third RCE.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 October 2005 has been entered.

***Response to Amendment***

Applicant's amendment of 7 October 2005 has been entered.

Claims 36-48 are pending and will be examined.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 42 refers to software access controls in firewalls, but is not further explained. Claim 43 refers to router implemented access restrictions that are not otherwise mentioned. Prior art will be interpreted to read on these claims where prior art discloses the use of firewalls.

Claims 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 44-47 refer to a "second plurality of secondary classes of objects" but fail to state whether these are part of the second subsection or the third subsection mentioned in claim 36.

Claim 48 refers to "said third plurality of secondary classes of objects" but there is no prior mention of a third plurality.

Claim 48 is indefinite in that it refers to objects that are configured to serve as *intermediaries* between [a] and [b], where [a] is a first plurality of secondary classes of objects and [b] is a second plurality of secondary classes of objects. There is no mention of intermediary objects in the disclosures. The only mention of somewhat related item is on page 8, line 4, which refers to intermediating modules such as report generator 136 and card production system 128. For purposes of this Examination, claim 48 will be interpreted to refer production of reports.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 36-48 are rejected under 35 U.S.C. 103(a) as being unpatentable Schein (US 6,226,623).**

Schein discloses the structures claimed in applicant's claims to a **system**: a **server** (as in Col. 9, line 62-Col. 10, line 7), a **database** (col. 12, lines 49-62, for example, a **firewall** (Col. 12, lines 63-67).

Schein does not use applicant's various divisions and labels for its various components. However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as Owens because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

**Alternatively, Claims 36-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein US 6,226,623 in view of Owens (US 6,047,267).**

The terms first, second and third high-level class, secondary classes will be given their broadest reasonable interpretation to read on logical or physical organization of data and executable code. The terms first, second and third subsections of a data repository will be given their broadest reasonable interpretation to read on logical or

physical divisions in databases. The term firewall will be given its broadest reasonable interpretation to read on software that permits filtering of data at various hardware and software levels.

**Schein** discloses a system and methods for creating and facilitating a plurality of stored value products, the system comprising:

**Servers.** See, for example, at least Fig. 6 and related text. Schein discloses *servers* configured to support [each of] said stored value products, to receive said transaction data from said transaction capture module, and to route said transaction data among said plurality of stored value products executing on said plurality of client systems; (see at least, Col. 9, line 62-Col. 10, line 7; see also at least references to multiple-user databases sharing of information and resources, Col. 7, lines 12-34; see references to location of various databases, including centralized data storage, and communication with various client systems that store and supply data to a centralized site, Col. 10, lines 41-56);

**Firewalls.** See, for example, Fig. 9 and related text.

**Data repositories.** See at least references to Databases, Fig. 7 and related text. The databases facilitate storage and retrieval of customer data, merchant data, and a plurality of data items (see at least, Col. 9, lines 42-47; see also references to centralized databases, Col. 10, lines 41-Col. 11, line 20). The databases comprise a plurality of data items, see at least, Col. 7, lines 13-33, describing service providers, financial institutions, their products, including stored-value products.



*Schein* discloses a server facilitating the operation of a plurality of stored value programs, each of said stored-value programs being associated with one of a plurality of client systems, the server comprising:

- (a) a digital computer in communication with a database maintaining consumer information, merchant information and a plurality of data items (see at least, Col. 9, line 42-Col. 10, line 7);
- (b) wherein each of said plurality of data items is configured to facilitate a particular function and to associate with each of said plurality of stored value programs (see at least, Col. 7, lines 13-33, describing service providers, financial institutions and their products), and
- (c) wherein each of said plurality of stored value programs accesses said consumer information and said merchant information via at least one of said plurality of data items (see at least, Col. 10, lines 41-56);
- (d) such that said consumer information and said merchant information is available to each of said plurality of financial products through a common interface available from the plurality of client systems. (see description of a common interface called a Global Integration Facility/GIF Col. 14, lines 36-51; see also references to client systems sending information to a centralized system, Col. 10, lines 28-65).

*As noted previously, Schein* discloses a method of facilitating financial transactions at a server, the method comprising the steps of:

- (a) selecting a first plurality of objects from a repository of objects to form a first stored value program, said first stored value program corresponding to a first

- financial product and being associated with a first client system (see at least Col. 3, line 65-Col. 6, line 65 for description of the art related to forming a first stored value program and its corresponding financial product; Col. 4, lines 39-5Col. 11, lines 11-48; Col. 12, lines 21-49 describing linking of various customer accounts and financial products; see also claim 20, above);
- (b) selecting a second plurality of objects from said repository of objects to form a second stored value program, said second stored value program corresponding to a second financial product and being associated with a second client system (see at least Col. 3, line 65-Col. 6, line 65 for description of the art related to forming a first stored value program and its corresponding financial product; Col. 4, lines 39-5Col. 11, lines 11-48; Col. 12, lines 21-49 describing linking of various customer accounts and financial products); and
- (c) accessing a *database* comprising consumer information and merchant information by said first and second client systems such that said first and second stored value programs interact with said *database* via said first and second pluralities of objects, respectively, to implement said first and second financial products on said first and second client systems, respectively (see at least Col. 7, lines 13-33; Col. 10, lines 41-56; see also utilization of common reports and customer demographic information available from stored objects that are created by any client system, Col. 10, lines 66-Col. 11, line 34).
- (d) an authorization server in communication with the database sever and the point-of-sale terminal, wherein the point of sale terminal is configured to query the

authorization server for transaction approvals. See, for example, at least Fig. 10 and related text, which describes that POS that connect customers, merchants and inquiring concerning credit rating of potential customers and links to authorization engines described in Fig. 2 and related text.

- (e) said plurality of objects comprising consumer information that is available to each of the plurality of stored value products and merchant information that is available to each of the plurality of stored value products. See, for example, at least Fig. 7 and related text, which describes customer information may be made available to derived objects. See also at least Col. 10, lines 41-56. Please see also rejections of claims 7 and 25 in previous Office Actions.

*Schein* discloses receiving a transaction request from a point of sale terminal, said transaction request corresponding to one of said financial products (see at least Col. 10, lines 41-56, Col. 15, lines 41-52; Col. 20, line 51-Col. 22, line 3).

*Schein* discloses determining a financial product corresponding to a transaction request at a transaction server, and further comprising a step of processing a transaction request in accordance with a first (or *n*th) plurality of data items if a transaction request corresponds to a first financial product (or *n*th). See at least, Col. 10, lines 41-Col. 12, line 49, describing the types of information available from the database. The information on the database is available for each transaction, and the transaction request is linked to a customer's products. A customer may have many products, each product associated with an object. These data items may also be referred to as a first through *n*th product.

*Schein* discloses separating a first and second financial product based upon a key value where said key value corresponds to a business unit. (see at least, Col. 5, lines 5 -Col. 67; Col. 6, line 7-Col. 7, line 46; Col. 10, lines 41- Col. 11, line 10 describes Database Management Systems. Database systems rely on unique and non-unique keys to store and access information. A key may identify CITIBANK, or a key may identify the CMMA CITIBANK MONEY MANAGEMENT ACCOUNT, as a separate business unit, if desired.

In summary, *Schein* discusses all limitations of applicants' invention, including stored value products such as smartcards and ATM cards. Client system computers may be connected to servers via the Internet (see at least Fig. 3, and Col. 15, line 53-Col. 16, line 7, Col. 21, lines 4-36; Col. 9, lines 57-Col. 10, line 7). *Schein* mentions several types of persistent repository mechanisms, including DB2, ORACLE (Col. 9, lines 1-67; see also application, page 17, lines 16-3). *Schein* discloses that other data models and structures may be applied (see at least Col. 6, lines 7-45, profiles and data models) and points out problems that arise when several sections in one or more clients maintain application-specific data and programs (see at least Col. 6, lines 25-44). Classes and objects are another way of modeling & data in persistent storage.

*Schein* **does not** use the words first, second and third high-level class. As applicant concedes, these words are found when one uses a data model called the "object-oriented" model. **Owens** discloses the use of relational databases in an object-oriented design in a multi-product on-line and Internet environment (see at least Abstract, Col. 1, lines 1-Col. 2, line 60, Col. 5, lines 36-Col. 7, line 30). **Owens**

discloses a system for administering a plurality of financial resources in an object-oriented paradigm where persistent storage takes place in relational database management scheme (see at least references to SQL, the Structured Query Language that is used to access relational databases, Col. 1, lines 19-60). **Owens** describes systems and methods for a system architecture that includes relational database information may be implemented in an object-oriented paradigm (see at least Col. 5, line 35-Col. 6, line 10), in various physical and logical configurations.

It would have been obvious to one of ordinary skill in the art of electronic-commerce to combine **Schein** and **Owens** to apply an object-oriented paradigm and describe plurality of financial products in terms of plurality of classes and plurality of objects. One of ordinary skill in the art of electronic-commerce would have been *motivated* to combine **Schein** and **Owens** to apply an object-oriented paradigm and describe plurality of financial products in terms of plurality of classes and plurality of objects for the *obvious reason* that the use of object oriented paradigm to describe data and interactions among data provides a more modern technique of how data interacts with business applications. Applying object-oriented terms permits one of ordinary skill in the art to reuse program code (classes) by instantiating a class into one or more objects that correspond to data items retrieved and used by different sub-systems.

The information on the centralized database is available to each of the client system databases for each transaction, and the transaction request is linked to a customer's products. In an object-oriented world, a customer may create (open/add/insert or other term) one or more financial product, including stored value products, and

each product may be associated with an object. This plurality of *objects* may also be referred to as a first, second, through nth product, just as the plurality of client systems may be referred to as a first client system, a second client system, etc.).

Schein uses Database Management Systems (DBMS), a series of modules that interpret the data storage means from a physical layout to a logical design set up by a database administrator (DBA). The DBMS modules include interfaces that permit developers to code programs to access the data and present the data to users. How the data is accessed varies according to type of database, including hierarchical, relational, object-relational database, hybrids, network databases, among others.

***As per claim 37***, Schein discloses ATMs, as in Col. 5, lines 3-33.

***As per claim 38***, Schein discloses business units, Col. 7, lines 4-33, Col. 10, lines 8-57.

***As per claim 39***, Schein discloses language , currency (Col. 18, lines 3-29).

***As per claim 40***, Schein discloses geographical, regional businesses, Col 18, lines 31-57.

***As per claim 41***, Schein discloses linked products, as in Col. 4, lines 39-56.

***As per claims 42-43***, Schein discloses firewalls. See, for example, Fig. 9 and related text.

***As per claim 44***, Schein discloses loading monetary value, as in crediting money, Col. 2, lines 7-34.

***As per claim 45***, Schein discloses deducting monetary values, as in debiting, reports, as in Col. 2, lines 7-34.

***As per claim 46***, Schein discloses activating a stored value product, as in Col. 5, lines 17-57.

***As per claim 47***, Schein discloses activating a stored value product, as in Col. 3, line 65-Col. 4, line 13.

***As per claim 48***, Schein discloses reports, as in Col. 6, lines 53-65.

### ***Response to Arguments***

Applicant's arguments filed 7 October 2005 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant argues that Schein and Owens disclose various features:

In general, Schein discloses a system and method for integrating data relating to customer transaction accounts based upon a customer's relationship with a financial institution. The Schein system logically links data from various accounts belonging to a customer to provide a more holistic view of the customer's relationship with the financial institution. Schein discloses a complex messaging system for managing data residing in geographically diverse locations while maintaining ensuring that homogeneous data remains integrated.

Owens discloses an object structure which allows a user to define new payment resources without requiring modifications to a relational database. An object server of Owens automatically generates appropriate tables and columns for the relational database. When a new payment source is added to an account, a secondary object representing the payment source is created which inherits the properties of the container object.

...Schein discloses a messaging structure for logically associating data relating to a customer...

In response to these comments, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that Schein "...does not provide an object structure for managing complex data within a tiered object architecture...." "...messaging structure..." The Examiner notes that **these features are not in the claims**. The claims do not mention complex data, tiered object architecture.

As admitted by applicant, "class" and "object" are found when one uses a data model called the "object-oriented" model. **Owens** discloses the use of relational databases in an object-oriented design in a multi-product on-line and Internet environment (see at least Abstract, Col. 1, lines 1-Col. 2, line 60, Col. 5, lines 36-Col. 7, line 30). **Owens** discloses a system for administering a plurality of financial resources in an object-oriented paradigm where persistent storage takes place in relational database management scheme (see at least references to SQL, the Structured Query Language that is used to access relational databases, Col. 1, lines 19-60). **Owens** describes systems and methods for a system architecture that includes relational database information may be implemented in an object-oriented paradigm (see at least Col. 5, line 35-Col. 6, line 10). The Examiner again notes that Owens was introduced to address applicant's concern over the absence of the words **object**, **class** in Schein. Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are



representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**James Zurita**  
**Patent Examiner**  
**Art Unit 2625**  
26 December 2005

*James Zurita*  
*Patent Examiner*